

R E M A R K S

Claims 1, 12, 13, 17, and 23 are amended. Claims 11, 20, and 26 are canceled. Claims 2-10, 14-16, 18, 19, 21, 22, 24, and 25 stand as originally filed. Re-examination and reconsideration are requested.

In the office action, paper number (unspecified), dated January 8, 2007, the examiner objected to claims 12 and 13 as containing certain typographical errors, as set forth in sections 5-7 of the office action. The examiner rejected claims 23-26 under 35 U.S.C. §112, second paragraph, as being indefinite for the reasons specified in sections 8-11 of the office action.

The examiner rejected claims 1, 3-8, 10, 14-19, and 21-25 under 35 U.S.C. §103(a) as being obvious over the publication to Carlson, et al., U.S. Patent Application Publication No. 2004/0044862 ("Carlson") in view of Mohan, et al., U.S. Patent No. 6,154,817 ("Mohan"). The examiner also rejected claims 2, 9, and 20 under Section 103(a) as being obvious over Carlson and Mohan in view of Blumenau, U.S. Patent No. 6,631,442 ("Blumenau").

While not expressly discussed in the office action, but as indicated in the Office Action Summary, the examiner objected to claims 11-13 and 26, presumably as depending from rejected base claims. Applicants assume, because these claims were not otherwise rejected, that claims 11-13 and 26 would be allowable if re-written in independent form to include the limitations of the base claims and any intervening claims from which they depend, and to address the Section 112 issues (re claims 12 and 13).

Re the Claims:

Claim 1 is amended to include the limitations of claim 11. Claim 1, and the claims depending therefrom (i.e., claims 2-10 and 12-16) should now be allowable.

Claim 11 is canceled because the subject matter thereof is now included in amended claim 1.

Claims 12 and 13 are amended per the examiner's suggestion to correct minor typographical errors and to change their dependencies in light of the cancellation of claim 11.

Claim 17 is amended to include the limitation previously contained in claim 20 and to include additional limitations like those of claim 11. No new matter is added. Claim 17, and the claims depending therefrom (i.e., claims 18, 19, 21, and 23) should now be allowable.

Claim 20 is canceled.

Claim 23 is amended to include the limitations of claim 26. Claim 23, and the claims depending therefrom (i.e., claims 24 and 25) should now be allowable.

Claim 26 is canceled.

Re the Objections to Claims 12 and 13:

The examiner objected to claims 12 and 12 as containing certain typographical errors. In response, applicants have amended claims 12 and 13 to correct the typographical errors. Applicants believe the objections are overcome.

Re the Rejections of Claims 23-26:

The examiner rejected claims 23-26 as being indefinite under Section 112, second paragraph, for the reasons noted in sections 8-11 of the office action. However, these rejections appear to be in error for two reasons. First, in explaining the rejections, the examiner refers to claim 8. However, none of claims 23-26 depend from claim 8. Second, the claim 8 language to which the examiner refers is not contained in claim 8. In fact, the cited language does not appear in any of the pending claims. Consequently, it appears that the examiner's section 112 rejections are erroneous. Therefore, applicants will regard claims 23-26 (in their original form) to be fully compliant with Section 112.

Re the Section 103 Rejections of Claims 1, 3-8, 10, 14-19, and 21-25:

5 The examiner rejected claims 1, 3-8, 10, 14-19, and 21-25 under 35 U.S.C. §103(a) as being obvious over Carlson in view of Mohan for the reasons stated in sections 12-24 of the office action. However, these rejections are now moot in light of the amendments to the claims.

10 Claim 1 is amended to include the limitations of claim 11. Because claim 11 was indicated as being allowable if rewritten in independent form (i.e., claim 11 was not rejected, only objected-to), claim 1, which now includes the limitations of claim 11, should now be allowable. Claims 3-8, 10, and 14-16 are allowable in that they depend from claim 1, which is now allowable.

15 Claim 17 is amended to include the limitations of claim 20 and to include additional limitations like those of claim 11, i.e., that the required number of scratch media is calculated by the planner "by dividing the average historical backup size of the backup job by an average capacity of a media type associated with the backup job." Therefore, claim 17, and the claims depending therefrom, i.e., claims 18, 19, 21, and 22, should now be allowable.

25 Claim 23 is amended to include the limitations of claim 26. Because claim 26 was indicated as being allowable if rewritten in independent form (i.e., claim 26 was not rejected, only objected-to), claim 23, which now includes the limitations of claim 26, should now be allowable. Claims 24 and 25 are allowable in that they depend from claim 23, which is now allowable.

30 Re the Section 103 Rejections 2, 9, and 20:

The examiner rejected claims 2, 9, and 20 under 35 U.S.C. §103(a) as being obvious over Carlson and Mohan in view of Blumenau. These rejections are moot in view of the amendments to claim 1 and the cancellation of claim 20. That is, because

the amendments to claim 1 place it in allowable form (for the reasons expressed above), claims 2, 9, which depend from claim 1, are allowable. Claim 20 is canceled, so the rejections of that claim are moot.

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Applicants believe that all of the claims pending in this patent application are allowable and that all other issues raised by the examiner have been rectified. Therefore, applicants respectfully request the examiner to reconsider the rejections and to grant an early allowance. If any questions or issues remain to be resolved, the examiner is requested to contact the applicants' attorney at the telephone number listed below.

Respectfully submitted,

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